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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/527,384

12/19/2006

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342837-2102

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12/17/2009

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EXAMINER

COUGHLIN, MATTHEW P

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

12/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/527,384	Applicant(s) FAROUZ ET AL.	
	Examiner Matthew P. Coughlin	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 21, 22, 25 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) 10, 11, 18, 21, 22, 25, 27, 28, 30 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 6, 9, 12-15, 17 and 29 is/are rejected.
- 7) ☒ Claim(s) 10-11, 18, 21-22, 25, 27-28 and 30-31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1-18, 21-22, 25, 27-31 are pending in the application. Claims 1-2, 4, 6, 9, 12-15, 17 and 29 are rejected. Claims 3, 5, 7-8 and 16 are objected to. Claims 10-11, 18, 21-22, 25, 27-28 and 30-31 are withdrawn from further consideration.

Election/Restrictions

Applicant has elected, with traverse, the species of Example 93 to prosecute the invention of Group I, claims 1-22 and 29. This requirement is still deemed proper and was made final in the office action dated September 4th, 2009.

The claims within elected Group I have been examined to the extent that they are readable on the elected species of Compound 93. Since no prior art was found on the elected species, the examination was expanded within elected Group I until art was found, in which case, the examination stopped and art has been applied against the claims. Note, M.P.E.P. § 803.02.

The subject matter of the expanded search is as follows:

The elected species, and

Compounds of formula I where R1 is phenyl or substituted phenyl, Q is unsubstituted C₂ alkenylene and W is -O-, and all other variables are defined within the instant claims.

Claims embraced by the above identified expanded search are claims 1-9, 12-17 and 29.

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Subject matter not embraced by the above identified expanded search and Claims 10-11, 18, 21-22, 25, 27-28 and 30-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim. Election was made **with traverse** in the reply filed on August 4th, 2009.

Response to Amendment

The objection to the abstract is withdrawn based on the instantly amended abstract, which provides a structure of the compounds claimed.

The objections to claims 12, 16, 29, 14 are withdrawn based on the instantly amended claims, which have corrected the various errors noted in the office action dated September 4th, 2009.

The rejection of claims 1-8, 12, 19 and 29 under 35 USC 112 2nd paragraph is withdrawn based on the instantly amended claims which do not cover isomers, generally, or prodrugs.

Applicant's amendments to the instant claims have rendered the rejection of claims 1, 2, 4-7, 12 and 19 under 35 USC 102(b) moot. This rejection has been withdrawn.

Claim Objections

Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 1 does not provide for R3 to be amino.

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It is suggested that Applicant delete the word "and" after species (41) in claim 18. Furthermore, it is suggested that Applicant replace the period after species (42) with a semicolon.

Claims 3, 5, 7-8 and 16 are objected to as being drawn in part to non-elected subject matter. Should Applicant render the following claim rejections moot by amendment, the search would be expanded to include the subject of these claims, which is presently withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 15 and rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 recited the variables R5-R7 and R8; however, these variables are not defined within the instant claims. Claim 17 recites the variable R8; however, R8 is not defined in the instant claims. Furthermore, each claim refers to a formula which is not found in the claims. Claim 15 refers to formula IIa; however, only formula II is shown. Similarly, claim 17 refers to formula IIIa; however, only formula III is shown.

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Claim Rejections - 35 USC § 102

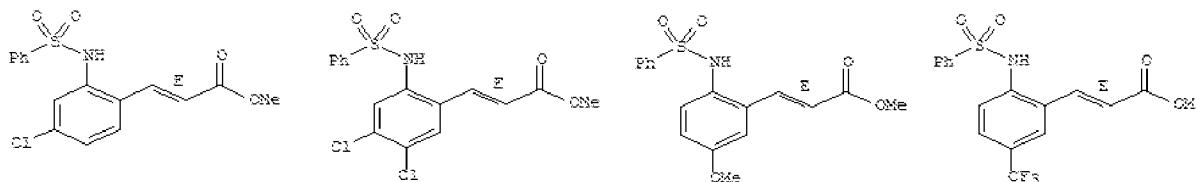
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

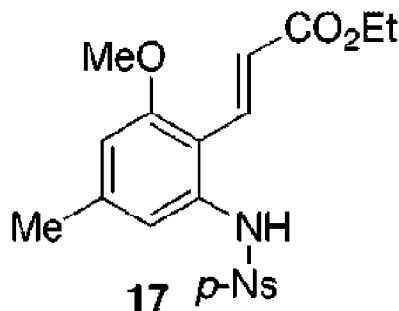
Claims 1-2, 4, 6, 9, 13, 14 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,303,628 by Nakao et al.

Nakao et al. teach the following compounds for use as intermediates en route to indole compounds and further teach them in ethanol. See Example 1, step 1. (CAS Registry No's. 231296-58-5, 231296-65-4, 231296-73-4, 231296-99-4):



Claims 1, 4, 6, 9, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Kambe et al. Org Lett. 2001, 3, 2575-2578.

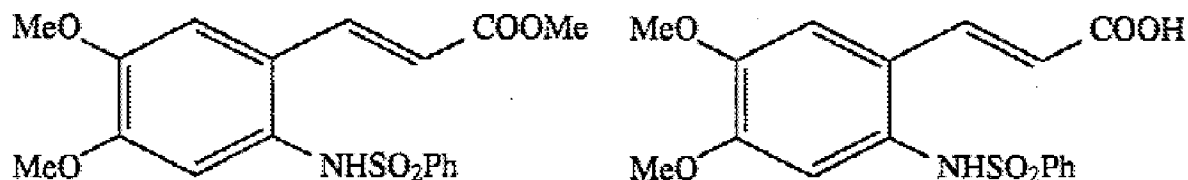
Kambe et al. teach the following species as intermediate in Scheme 4:



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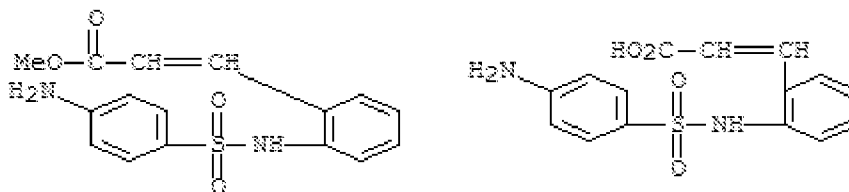
Claims 1, 2, 4, 6, 9, 13 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,534,654 by Ohtani et al.

Ohtani et al. teach the following compounds as intermediates en route to hydroxamic acids and further teach as aqueous solutions during workup (See column 36):



Claims 1, 4, 6, 9, 12, 17 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Gorvin, J. H. J. Chem. Soc. 1949, 3304-3311.

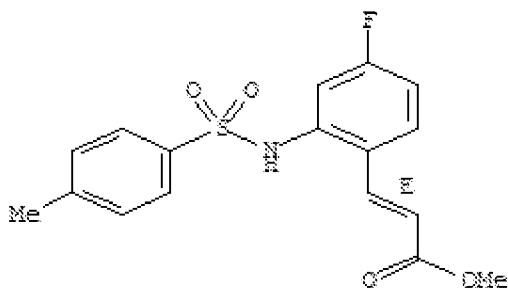
Gorvin teaches the following two compounds on page 3307 during the preparation of 2-sulphanilamidocinnamamide and teach the methyl ester in an aqueous solution:



Claims 1-2, 4, 6, 9, 12, 13, 14 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,608,070 by Nakao et al.

Nakao et al. teach the following species (CAS Registry No. 231297-59-9):

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NOTE: Although not explicitly discussed herein, applicant is advised to note that this reference is replete with species representative of the instantly claimed genus. Consequently, any amendments to the claims to overcome rejections rendered under 35 U.S.C. § 102 should address this reference as a whole and should not be limited to the species discussed or disclosed explicitly herein.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew P. Coughlin whose telephone number is (571)270-1311. The examiner can normally be reached on Monday through Thursday from 7:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew P. Coughlin/
Examiner, Art Unit 1626

/Rebecca L Anderson/
Primary Examiner, Art Unit 1626